

REMARKS

Claims 1-7 remain in this application. Claims 1-4 are amended. Claims 5-7 are new. No new matter is introduced.

Claims 1-2 are rejected under 35 U.S.C. §102(b) as being anticipated by Dempsey (506,102), Williams et al (4,557,389), or Ramsey et al (6,168,018). Furthermore, Claims 1-4 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wobber (1,560,009) and Arblaster (3,397,434); Claims 1-3 are rejected under 35 U.S.C. §103(a) as being unpatentable over Feldman et al (1,840,193). Applicant would like to traverse the Examiner's rejection below by pointing out several important differences between the socket holder of the present invention and those taught by the references cited by the Examiner.

To better illustrate some of the key elements of the present invention, Claim 1, as amended, is duplicated below:

Claim 1:

1. A tool holder for holding a plurality of tools, comprising:

a plurality of holding portions, each for holding a tool with a specification; and

a plurality of specification marking members, *each of said specification marking members being respectively integral with a holding portion* for showing the specification of the tool to be held thereon;

wherein each of said specification marking members comprises a retaining portion and a marking portion, said retaining portion extends directly from said holding portion, *and said marking portion is removably retained in said retaining portion.*

Applicant respectfully submits that one of the key elements of the present invention as recited in Claim 1 is that each of the specification marking member is **respectively integral** with the corresponding holding portion, and that the marking portion of the specification marking member is **removably retained** in the retaining portion of the specification marking member. None of these elements are taught or suggested in any of the prior art references cited by the Examiner, including the Dempsey (506,102), Williams et al (4,557,389), Ramsey et al (6,168,018), Wobber (1,560,009), Arblaster (3,397,4340), and the Feldman et al (1,840,193) references, either alone or in combination thereof.

As discussed above, Applicant respectfully submits that none of the prior art references cited by the Examiner taught or suggested a socket holder which contains a plurality of specification marking members, each being specifically integral with a separate holding portion (each of the holding portions is provided to hold a tool), and that each specification marking member contains a removable marking portion (for identifying the tool to be held in the corresponding holding portion) that is removably retained in the retaining portion of the same specification marking member. Applicant also respectfully submits that, while Ramsey et al reference teaches a socket holder which removable labels, those labels are collectively affixed to the main body of the tool holder, they are not separate and are not respectively integral with the retaining portion. The socket holder taught in the Ramsey et al reference is totally different and patentably distinguishable from the tool holder of the present invention, wherein, as part of the specification marking member, the removable marking portion is respectively integral with corresponding retaining portion. In other words, in the present invention, the combination of the retaining portion/marketing portion forms a separate unit which can be moved around. This is impossible with the Ramsey et al invention, all the labels are affixed onto the same body.

Applicant respectfully submits that it has been clearly established that "anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention". Structural Rubber Prod. Co. v. Park Rubber Co. 223 USPQ 1264 (Fed. Cir. 1984). It has been held by the Federal Circuit that in order "[f]or a prior-art reference to anticipate, every element of the claimed invention must be *identically* shown in a single reference" (*emphasis added*).

In re Bond, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). More recently the Federal Circuit reiterated that "a rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference". In re Paulsen, 31 USPQ 2d 1671 (Fed. Cir. 1994).

Therefore, Applicant respectfully submits, since many of the key elements of the present invention are missing from any of the prior art references cited by the Examiner, it cannot be said that the present invention is anticipated, and the Examiner's Section 102 anticipation rejection must be withdrawn:

Furthermore, as discussed above, none of the references, either alone or in combination thereof, taught or suggested many of the key elements of the present invention. Applicant respectfully submits that, since many of the important limitations are lacking from the prior art teaching, a prima facie case cannot be made. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988).

In light of the foregoing, it is believed that the present invention is in condition for allowance. And Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner has any question, he or she is invited to call or fax Applicant's counsel at the telephone numbers below.

Respectfully Submitted,

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Date

PTO Customer No. 022192



W. Wayne Liauh, Reg. No. 34,212
Law Office of Liauh and Associates
4224 Waialae Ave., Suite 5-388
Honolulu, HI 96816
Telephone: (775) 363-2886
Telecopier: (775) 599-0768